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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

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Name _____

Application Number

09/891,163

Filed

06/25/2001

First Named Inventor

Stiffler

Art Unit

3629

Examiner

Plucinski

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the



applicant/inventor.



assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)



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Registration number if acting under 37 CFR 1.34 _____

April 25, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below.

*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Claims 1, 4, 7-9, 12-13, 16, 62, 65 and 68 stand rejected under 35 USC 102(e) as being anticipated by Lederer; Claims 2, 5, 10 and 14 have been rejected as either anticipated or obviated by Lederer; and, Claims 3, 6, 11, 15, 63-64 and 66-67 have been rejected under 35 USC § 103 as being unpatentable over Lederer.

The application claims methods and systems for facilitating international shipment of goods to enable centralized control for establishing international shipping requirements and responding to changes in international shipping requirements. Users query the system through remote terminals to request requirements for one or more specified countries and the requirement information is provided in response to the request. The requirement information may be delivered in matrix format showing core requirements relating to all shipments and country-specific requirements relating to specified origination and/or destination countries.

The Lederer publication is directed to an order processing system wherein a Global Regulatory Compliance System (GRCS) receives product orders and determines whether it can process the order (§ [0072], lines 1-2). The GRCS determines if the customer and product specified in the order are known to the GRCS system (§ [0072], lines

2-4). If the customer and product are known to the GRCS, then the GRCS determines if a Material Safety Data Sheet (MSDS) identifying the product constituents, is stored for the ordered product. If so, the GRCS uses the MSDS to determine if the product can be shipped to the indicated order destination (§ [0077], lines 1-7). If the product can be shipped, the GRCS may either send an indication that the shipment is permitted or be silent and have silence construed as an indication that shipment is permitted (§ [0077], lines 8-15). If an MSDS does not exist, the GRCS may transmit an MSDS to be completed for the ordered product. The GRCS makes its determination of whether a product can be shipped to the indicated order destination based on information obtained by the GRCS from a product information system and a regulation source system maintained by an independent regulatory agency (108 and 112 of Fig. 1; § [0044] and [0045]).

The examiner has erred in rejecting the claims as anticipated and/or obviated by Lederer. With reference to the claim features, the claims recite a method, system and program storage product that includes steps and means for storing core requirements applicable to a plurality of countries as well as country-specific requirements. Lederer does not store core requirements or country-

specific requirements. Rather, Lederer stores an MSDS or contacts a regulation source system to obtain MSDS information. Further, the claims recite steps and means for receiving a request from a requester for requirements for one or more selected countries. The GRCS system in Lederer receives a product order. The pending claims recite steps and means for determining if country-specific requirements are stored for the one or more selected countries. Lederer determines whether the product and customer specified in the order are known to the GRCS system. The claims recite steps and means for providing core requirements and available country-specific requirements to the requester. In contrast, Lederer sends an indication of whether the ordered product can be shipped. Clearly Lederer doesn't anticipate the invention.

Anticipation under 35 USC 102 is established only when a single prior art reference discloses each and every element of a claimed invention. See: In re Schreiber, 128 F. 3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997); In re Paulsen, 30 F. 3d 1475, 1478-1479, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994); In re Spada, 911 F. 2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990) and RCA Corp. v. Applied Digital Data Sys., Inc., 730 F. 2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). Since the Lederer patent

publication does not teach the system, program product and method including steps and means for storing core requirements and country-specific requirements, receiving a request for requirements for at least one selected country and providing core requirements and available country-specific requirements to the requester, it cannot be maintained that Lederer anticipates the language of independent Claims 1, 4, 7, 62, 65 and 68 or the claims which depend therefrom and add limitation thereto.

With respect to independent Claims 8, 12 and 16, Lederer does not teach a system, method or program product including means and steps for requesting, on a computer, international shipping requirements for at least one selected country; receiving, on the computer, core international shipping requirements applicable to a plurality of countries and an indication of respective country-specific requirements available for the at least one selected country. Rather, as detailed above, Lederer receives a product order, determines whether it can process the order, and either replies that the order can be sent or simply sends the order. Applicants believe that Lederer does not anticipate the invention as recited in Claims 8, 12 and 16 and those claims which depend therefrom and add limitations thereto.

Claims 3, 6, 11, 15, 63-64 and 66-67, have been rejected under 35 USC § 103 as being unpatentable over Lederer. Applicants rely on the above arguments with respect to the teachings of Lederer which do not anticipate the features of the independent claims from which Claims 3, 6, 11, 15, 63-64 and 66-67 depend. Moreover, Applicants contend that Lederer does not teach or suggest providing its regulations in a matrix format. Since Lederer teaches that it sends an indication of whether a product can be shipped, or even allows a lack of response to indicate that a product can be shipped, it cannot be maintained that Lederer teaches or suggests multiple results, let alone that the results be rendered in a matrix format.

Applicants assert that, for a determination of obviousness, the prior art must teach or suggest all of the claim limitations. "All words in a claim must be considered in judging the patentability of that claim against the prior art" (In re Wilson, 424 F. 2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970)). If the cited references fail to teach each and every one of the claim limitations, a *prima facie* case of obviousness has not been established by the Examiner. Since Lederer does not teach all of the limitations of the claims, a rejection under 35 USC 103 cannot be maintained.